



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,043	01/23/2002	Thomas C. Hunt		5788

7590  
Ted Masters  
23344 8th Street  
Newhall, CA 91321

EXAMINER

RADA, ALEX P

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 11/03/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

## Interview Summary

Application No.

10/055,043

Applicant(s)

HUNT ET AL.

Examiner

Alex P. Rada

Art Unit

3714

All participants (applicant, applicant's representative, PTO personnel):

(1) Alex P. Rada.

(3) Tom Hughes.

(2) Ted Masters Reg. No. 36,209.

(4) \_\_\_\_\_.

Date of Interview: 29 October 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1.

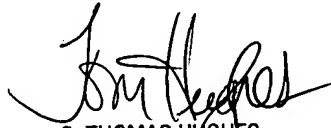
Identification of prior art discussed: None.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant's representative faxed over proposed claim language to overcome the 101 rejection. The examiner agreed that the proposed claim language overcomes the 101 rejection. Further arguments regarding the art rejection would be filled in due course.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

#### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

##### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

10/21/03-Application No. 10/055,043

**Attachment 1**

**SAMPLE AMENDMENT ONLY, NOT FOR THE RECORD**

1. A method **for four players to play** [of playing] a modified game of chess, comprising:

(1) providing a playing area, said playing area having 144 playing stations arranged in a 12 by 12 matrix, said playing stations being of two alternating types, said playing area having four sides, each said side having (1) 12 said playing stations eight of which are middle playing stations wherein two said playing stations are disposed on either side of said eight middle playing stations, and (2) eight inner playing stations disposed in inward abutting relationship with said eight middle playing stations;

(2) providing four sets of chess pieces;

(3) placing one said set of chess piece in conventional starting arrangement upon said eight middle playing stations and said eight inner playing stations of each said side of said playing area;

(4) [providing four players,] one said player disposed adjacent to each said side of said playing area, wherein said set of chess pieces disposed on a particular side of said playing area belong to said player who is also disposed on said particular side;

(5) providing rules of play, said rules of play including:

- conventional rules of chess play;
- additional rules of play which modify said conventional rules of chess play, said additional rules of play including:
  - said four players sequentially taking turns moving their said chess pieces; and,

(6) said four players playing a modified game of chess in accordance with said rules of play.

**Claims 7, 13, 19, 23, 27, and 33 would be similarly amended.**

Date: October 21, 2003

To: Examiner Alex P. Rada , GAU 3714  
Supervisor Tom Hughes, GAU 3714

From: Ted Masters, Reg. No. 36,209

Subject: Application No. 10/055,043, Claim Rejections - 35 USC § 101

Attachment: (1) Amended Claim 1

Dear Examiner Rada and Supervisor Hughes,

I have been a patent practitioner for over 11 years. During that time, I have successfully prosecuted dozens of U.S. patent applications which contain method claims directed to processes which include a representation of a human being as an integral and necessary element of the claimed process. However your office has issued a 35 USC § 101 rejection on the subject application which states "providing living subject matters (human beings) for a game" is non-statutory.

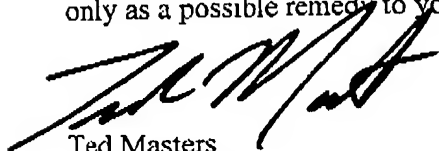
I hope then that you can appreciate my confusion as a patent practitioner when I am confronted with what I believe to be an apparent inconsistency and/or reversal in PTO policy. Since your position on the subject application appears to be inconsistent with my experience, and also with thousands and thousands of issued U.S. patents, I respectfully request a telephone conversation to discuss the following items in question:

1. Since 35 USC § 101 states that processes are patentable, and does not specifically prohibit the recitation of human beings in process patents, what is the underlying basis of the 101 rejection of the subject application?
  - (a) another section of 35 USC?
  - (b) 37 CFR?
  - (c) MPEP?
  - (d) case law?
  - (e) a new PTO-wide policy?
2. In the rejected claims, what is actually being rejected?
  - (a) reciting a human being or a representation of a human being (such as a player or dealer) in the body of the claim?\*
  - (b) the language used to recite the human being or representation of a human being recited in the body of the claim? For example is "providing" language (such as in "providing four players" specifically objectionable, while other language such as "said four players playing a modified. . . " not objectionable?

\* Claims 1 and 2 of U.S. Patent 6,511,072, issued Jan 28, 2003, examined by yourselves, appears to contain such recitations.

3. Are any recitations of a human being or a representation of a human being acceptable in claims? In the preamble? In the body of a claim? If so, could you please provide examples of what you believe to be acceptable language which recites a human being or representation of a human being?

4. Attachment 1 includes an amended Claim 1 which is intended for discussion purposes only as a possible remedy to your rejections of the subject application.



Ted Masters  
(661) 255-2333